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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/823,152

04/12/2004

Philip A. Carpino

PC25808A

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7590

08/04/2008

PFIZER INC.  
PATENT DEPARTMENT, MS8260-1611  
EASTERN POINT ROAD  
GROTON, CT 06340

EXAMINER

DESAI, RITA J

ART UNIT

PAPER NUMBER

1625

NOTIFICATION DATE

DELIVERY MODE

08/04/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

~IPGSGro@pfizer.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/823,152	<b>Applicant(s)</b> CARPINO ET AL.	
	<b>Examiner</b> Rita J. Desai	<b>Art Unit</b> 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 8-11, 31, 35, 36, 42, 43, 49, 55, 59 and 64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 8-11, 31, 35, 36, 42, 43, 49, 55, 59 and 64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 1625

### DETAILED ACTION

Claims 1, 4, 8-11, 31, 35, 36, 42, 43, 49, 55, 59 and 64 are pending.

( Applicants pending claims does not include 36 , however claim 36 is pending and has not been cancelled.)

The rejection under 35 USC 112 first para still stands.

Applicants argue that SR141716A was not approved is immaterial.

This is incorrect.

The examiner has used the example to show the unpredictability in the art. Chemical and pharmaceutical art is highly unpredictable.

In addition *In re Fouche* 169 USPQ 429 dealt with a similar issue with respect to how to use requirement of 112 1<sup>st</sup> paragraph,

“Inclusion of representative examples is not required to enable a person skilled in the art to use a generic invention; nevertheless, applicant must use some technique of providing teaching **of how to use which is commensurate with breadth of protection sought by claim, unless such knowledge is already available to persons skilled in the art**; thus, where applicant undertakes to define invention by recitation of a Markush group, he must enable one skilled in the art to make and use at least one composition employing each member of group.

Both the examiner and the board noted that none of the working examples pertained to compounds wherein Z was heterocyclic. Appellant is quite correct in contending that, under our decisions in *In re Robins*, 57 CCPA 1321, 429 F.2d 452, 166 USPQ 552 (1970), the inclusion of representative examples is not required to enable a person skilled in the art to use a generic invention. Nevertheless, an applicant must use *some* technique of providing teaching of how to use which is commensurate with the breadth of protection sought by the claim, unless such knowledge is already available to persons skilled in the art.

It seems clear, and it is not disputed by appellant, that where an applicant undertakes to define his invention by the recitation of a Markush group, he must enable one skilled in the art to make and use at least one composition employing each member of the Markush group. The examiner and the board did not believe that appellant had done so as to the heterocyclic members of the group. While they noted the absence of examples using heterocyclic moieties, we do not find that they viewed examples as mandatory. The issue before us is whether appellant has provided *any* teaching of how to use compounds containing the heterocyclic members of the Markush group. The only reference to heterocyclic radicals in the specification is the statement that “the invention provides” compounds of the structure shown in claim 1, wherein Z may be, among

Art Unit: 1625

other possibilities, a mononuclear, nitrogen-containing heterocycle connected to the chain A by the nitrogen atom, and optionally containing an oxygen, sulphur, or second nitrogen atom in the ring and optionally substituted by one of more alkyl radicals containing 1 to 5 carbon atoms each, such as 1-pyrrolidyl, piperidino, morpholino, 1-piperazinyl, or 4-alkyl-1-piperazinyl. “

In view of the art and the predictability in the art applicants have not provided any examples with the R<sub>4</sub> being a heterocyclic group such as piperidinyl, pyrrolidinyl or morpholin-4-yl.

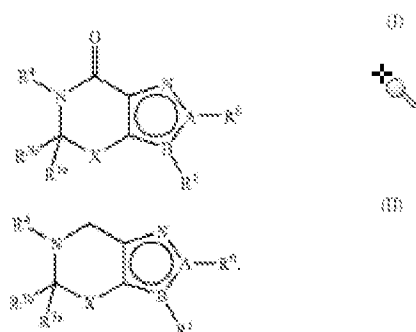
There are no tests done only some description of assays.

Another example is that of fluphenazine an approved drug for the treatment of psychotic disorders, which binds to the 5-HT<sub>6</sub> receptor. LSD also binds the 5-HT<sub>6</sub> receptor. According to applicants reasoning LSD should be used to treat psychotics .

Applicants arguments is thus not found to be persuasive and the rejection still stands.

The double patenting rejection over US 7, 230,024 still stands.

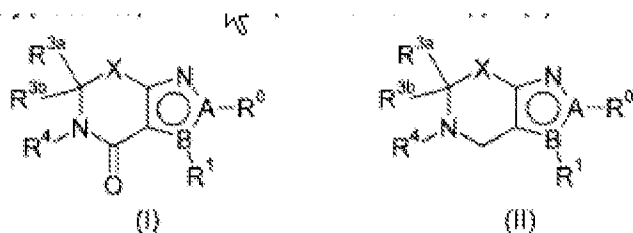
It discloses compounds of the formula



, wherein X is a bond. A is N and B is a carbon.

Applicants compounds are

Art Unit: 1625



The difference is in the position of the, X, NR<sub>4</sub>, and =O or CH<sub>2</sub>. The order is the same just the attachment is in the anticlockwise, instead of the clockwise, making them positional isomer.

The ODP on 7241788, 7141669 and 7145012 has been withdrawn as applicants arguments have been convincing, as '669, '012 both are drawn to 6 membered rings and '788 are drawn to imidazoles.

### *Conclusion*

Claims 1, 4, 8-11, 31, 35, 36, 42, 43, 49, 55, 59 and 64 are rejected.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 1625

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, flex time..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rita J. Desai/  
Primary Examiner, Art Unit 1625

R.D.  
July 29, 2008